

IN THE DRAWINGS:

The attached replacement sheets of drawings, 1/4-4/4, include new Figures 7-9. These replacement sheets, which include Figures 1-9, replace the previously filed sheets 1/4-4/4 including Figures 1-6.

REMARKS

The final Office Action mailed February 7, 2007 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1, 5, 7-9, 11-13 and 15-21 are now pending in this application. Claims 1, 5, 7-9, 11-13 and 15-21 stand rejected. Claims 2-4, 6, 10 and 14 have been canceled.

Applicants note the objection to the drawings under 37 CFR 1.83(a). By the above amendment, Applicants have added Figures 7-9. More specifically, Applicants have added Figures 7-9 to properly identify the telescoping construction of expandable beverage holder 130. Support for these new figures is found throughout Applicants' specification, for example at paragraphs [0024] – [0028]. No new matter has been added. Applicants respectfully submit that the above amendment overcomes the objection to the drawings by showing every feature of the claimed invention and notification to that effect is respectfully solicited.

The rejection of Claims 9, 19 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,116,045 to Hodosh et al. (hereinafter referred to as "Hodosh") is respectfully traversed.

Hodosh describes a portable insulated container (100) that includes a top panel (104) which defines a storage space (132). The insulated container (100) also includes a zipper (120) for coupling the top panel (104) to the container (100). The top panel (104) also includes a pair of receptacles (152 and 154) extending through the top panel (104). The receptacles (152 and 154) include a well assembly (162) that includes a downwardly extending peripheral wall member (182) that comprises a waterproof skirt or membrane having a closed base portion (184). Specifically, the waterproof skirt downwardly extends into the storage space (132). More specifically, the receptacles (152 and 154) are configured to receive beverages can or bottles within the downwardly extending skirt (182). Notably, Hodosh does not describe or suggest an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration,

in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.

Claim 9 recites a container comprising “an insulated body comprising outer walls and a base, the insulated body defining a storage space; an insulated cover movably coupled with the insulated body; and an expandable beverage holder integrated with the insulated cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.”

Hodosh does not describe or suggest a container, as recited in Claim 9. Specifically, Hodosh does not describe or suggest a container comprising an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space, as required by Applicants’ claimed invention. Rather, in contrast to the present invention, Hodosh describes an insulated container that includes a pair of receptacles coupled within a top panel, wherein the receptacles include a waterproof skirt that only extends downwardly into a storage space and does not use telescoping construction. As such, Applicants respectfully submit that Hodosh neither describes nor suggests such a limitation as recited in Claim 9.

Accordingly, for at least the reasons set forth above, Claim 9 is submitted to be patentable over Hodosh.

Claim 19 depends from independent Claim 9. When the recitations of Claim 19 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claim 19 likewise is patentable over Hodosh.

Claim 21 recites an insulated container comprising “a body comprising outer walls and a base, the body defining a storage space and configured to prevent heat transfer out of the storage space; a cover configured to couple with the body and to prevent heat transfer out of the storage space; and an expandable beverage holder configured to couple to the cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space and configured to hold a beverage container.”

Hodosh does not describe or suggest an insulated container, as recited in Claim 21. Specifically, Hodosh does not describe or suggest an insulated container comprising an expandable beverage holder configured to couple to the cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space and configured to hold a beverage container, as required by Applicants’ claimed invention. Rather, in contrast to the present invention, Hodosh describes an insulated container that includes a pair of receptacles coupled within a top panel, wherein the receptacles include a waterproof skirt that only extends downwardly into a storage space and does not use telescoping construction. As such, Applicants respectfully submit that Hodosh neither describes nor suggests such a limitation as recited in Claim 21.

Accordingly, for at least the reasons set forth above, Claim 21 is submitted to be patentable over Hodosh.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 9, 19 and 21 be withdrawn.

The rejection of Claims 1, 5, 8, 9, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,364,329 to Holub et al. (hereinafter referred to as “Holub”) in view of U.S. Patent No. 5,511,755 to Spykerman (hereinafter referred to as “Spykerman”), of record, is respectfully traversed.

Holub describes a cooler (100) including a lid (110) formed using conventional blow molding techniques. The lid (110) includes cup holders (116). Notably, Holub does not describe or suggest an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.

Spykerman describes a container holder (10) including cup-shaped members (18, 20) that are movable between a first position, as shown in Figure 2, for holding a larger diameter container and a second position, as shown in Figure 3, for holding a smaller diameter container. Notably, Spykerman does not describe or suggest an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.

Claim 1 recites an insulated container comprising “a body comprising outer walls and a base defining a storage space and configured to prevent heat transfer out of the storage space; a cover configured to couple with the body and to prevent heat transfer out of the storage space; and an expandable beverage holder configured to couple to the cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space and configured to hold a beverage container, a bottom of the expandable beverage holder configured to prevent heat transfer.”

Neither Holub nor Spykerman, considered alone or in combination, describes or suggests an insulated container, as recited in Claim 1. More specifically, neither Holub nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable

beverage holder one of extending away from the storage space and extending into the storage space and configured to hold a beverage container, a bottom of the expandable beverage holder configured to prevent heat transfer, as required by Applicants' claimed invention. Rather, in contrast to the present invention, Holub describes a molded lid that includes non-moveable cup holders, and Spykerman describes cup-shaped members that may move from a first position to a second position but are not expandable.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Holub in view of Spykerman.

Claims 5 and 8 depend from independent Claim 1. When the recitations of Claims 5 and 8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 5 and 8 likewise are patentable over Holub in view of Spykerman.

Claim 9 recites a container comprising "an insulated body comprising outer walls and a base, the insulated body defining a storage space; an insulated cover movably coupled with the insulated body; and an expandable beverage holder integrated with the insulated cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container."

Neither Holub nor Spykerman, considered alone or in combination, describes or suggests a container, as recited in Claim 9. More specifically, neither Holub nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space, as required by Applicants' claimed invention. Rather, in contrast to the present invention, Holub describes a molded lid that includes non-moveable cup holders, and

Spykerman describes cup-shaped members that may move from a first position to a second position but are not expandable.

Accordingly, for at least the reasons set forth above, Claim 9 is submitted to be patentable over Holub in view of Spykerman.

Claims 18 and 19 depend from independent Claim 9. When the recitations of Claims 18 and 19 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 18 and 19 likewise are patentable over Holub in view of Spykerman.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1, 5, 8, 9, 18 and 19 be withdrawn.

The rejection of Claims 1, 5, 7-9, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2005/0072181 to Mogil et al. (hereinafter referred to as “Mogil”) in view of Spykerman, of record, is respectfully traversed.

Spykerman is described above.

Mogil describes an insulated container including a lid (334) including circular recesses or depressions (342) to steady a beverage placed therein. Notably, Mogil does not describe or suggest an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.

Claim 1 recites an insulated container comprising “a body comprising outer walls and a base defining a storage space and configured to prevent heat transfer out of the storage space; a cover configured to couple with the body and to prevent heat transfer out of the storage space; and an expandable beverage holder configured to couple to the cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the

expandable beverage holder one of extending away from the storage space and extending into the storage space and configured to hold a beverage container, a bottom of the expandable beverage holder configured to prevent heat transfer.”

Neither Mogil nor Spykerman, considered alone or in combination, describes or suggests a container, as recited in Claim 1. More specifically, neither Mogil nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space, as required by Applicants’ claimed invention. Rather, in contrast to the present invention, Mogil describes a lid that includes circular recesses defined therein which are used to merely steady a beverage placed with the recess, and Spykerman describes cup-shaped members that may move from a first position to a second position but are not expandable.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Mogil in view of Spykerman.

Claims 5, 7 and 8 depend from independent Claim 1. When the recitations of Claims 5, 7 and 8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 5, 7 and 8 likewise are patentable over Mogil in view of Spykerman.

Claim 9 recites a container comprising “an insulated body comprising outer walls and a base, the insulated body defining a storage space; an insulated cover movably coupled with the insulated body; and an expandable beverage holder integrated with the insulated cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.”

Neither Mogil nor Spykerman, considered alone or in combination, describes or suggests a container, as recited in Claim 9. More specifically, neither Mogil nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space, as required by Applicants' claimed invention. Rather, in contrast to the present invention, Mogil describes a lid that includes circular recesses defined therein which are used to merely steady a beverage placed with the recess, and Spykerman describes cup-shaped members that may move from a first position to a second position but are not expandable. Accordingly, for at least the reasons set forth above, Claim 9 is submitted to be patentable over Mogil in view of Spykerman.

Claims 18 and 19 depend from independent Claim 9. When the recitations of Claims 18 and 19 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 18 and 19 likewise are patentable over Mogil in view of Spykerman.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1, 5, 7-9, 18 and 19 be withdrawn.

The rejection of Claims 1, 8, 9, 11-13, 17, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Holub in view of U.S. Patent No. 6,834,838 to Dennis et al. (hereinafter referred to as "Dennis") is respectfully traversed.

Holub is described above.

Dennis describes a cupholder (100) coupled to a console (104) of an automobile, wherein the cupholder (100) includes a stationary cylindrical component (102) and a moveable cylindrical component (108) coupled within the stationary component (102). The moveable component (108) is telescopically moveable with respect to the stationary component (102). When the moveable component (108) is telescopically extended away from the console (104), the combination of the two components (102 and 108) provides a

depth for a beverage container (110) to be inserted therein. Notably, Dennis does not describe or suggest an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Holub nor Dennis, considered alone or in combination, describes or suggests the claimed combination. Further, in contrast to the Examiner's assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Holub and Dennis, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory assertion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art suggests combining the disclosures.

As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant." In re Kotzab, 54 U.S.P.Q.2d 1308, 1316 (Fed. Cir. 2000); M.P.E.P. 2143.01.

Further, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). The Federal Circuit has determined that:

[i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot

use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”
In re Fritch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 U.S.P.Q. 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, or any reasonable expectation of success has been shown.

Accordingly, since there is no teaching or suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for at least this reason, Applicants submit that Claims 1, 8, 9, 11-13, 17, 18 and 20 are patentable over Holub in view of Dennis.

Claim 1 recites an insulated container comprising “a body comprising outer walls and a base defining a storage space and configured to prevent heat transfer out of the storage space; a cover configured to couple with the body and to prevent heat transfer out of the storage space; and an expandable beverage holder configured to couple to the cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space and configured to hold a beverage container, a bottom of the expandable beverage holder configured to prevent heat transfer.”

Neither Holub nor Dennis, considered alone or in combination, describes or suggests an insulated container, as recited in Claim 1. More specifically, neither Holub nor Dennis,

considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space, as required by Applicants' claimed invention. Rather, in contrast to the present invention, Holub describes a molded lid that includes non-moveable cup holders, and Dennis describes a cupholder that includes a moveable cylindrical component that extends telescopically away from a stationary cylindrical component that is coupled to a console of an automobile.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Holub in view of Dennis.

Claim 8 depends from independent Claim 1. When the recitations of Claim 8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claim 8 likewise is patentable over Holub in view of Dennis.

Claim 9 recites a container comprising "an insulated body comprising outer walls and a base, the insulated body defining a storage space; an insulated cover movably coupled with the insulated body; and an expandable beverage holder integrated with the insulated cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container."

Neither Holub nor Dennis, considered alone or in combination, describes or suggests a container, as recited in Claim 9. More specifically, neither Holub nor Dennis, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space, as required by Applicants' claimed invention. Rather, in contrast to the

present invention, Holub describes a molded lid that includes non-moveable cup holders, and Dennis describes a cupholder that includes a moveable cylindrical component that extends telescopically away from a stationary cylindrical component that is coupled to a console of an automobile.

Accordingly, for at least the reasons set forth above, Claim 9 is submitted to be patentable over Holub in view of Dennis.

Claims 11-13, 17, 18 and 20 depend from independent Claim 9. When the recitations of Claims 11-13, 17, 18 and 20 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 11-13, 17, 18 and 20 likewise are patentable over Holub in view of Dennis.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1, 8, 9, 11-13, 17, 18 and 20 be withdrawn.

The rejection of Claims 1, 7-9, 11, 12, 17, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Mogil in view of Dennis is respectfully traversed.

Mogil and Dennis are described above.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Mogil nor Dennis, considered alone or in combination, describes or suggests the claimed combination. Further, in contrast to the Examiner's assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Mogil and Dennis, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory assertion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art suggests combining the disclosures.

As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 54 U.S.P.Q.2d 1308, 1316 (Fed. Cir. 2000); M.P.E.P. 2143.01.

Further, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). The Federal Circuit has determined that:

[i]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” In re Fritch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 U.S.P.Q. 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching or suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for at least this reason, Applicants submit that Claims 1, 7-9, 11, 12, 17, 18 and 20 are patentable over Mogil in view of Dennis.

Claim 1 recites an insulated container comprising “a body comprising outer walls and a base defining a storage space and configured to prevent heat transfer out of the storage space; a cover configured to couple with the body and to prevent heat transfer out of the storage space; and an expandable beverage holder configured to couple to the cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space and configured to hold a beverage container, a bottom of the expandable beverage holder configured to prevent heat transfer.”

Neither Mogil nor Dennis, considered alone or in combination, describes or suggests an insulated container, as recited in Claim 1. More specifically, neither Mogil nor Dennis, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending away from the storage space and extending into the storage space, as required by Applicants’ claimed invention. Rather, in contrast to the present invention, Mogil describes a lid that includes circular recesses defined therein which are used to merely steady a beverage placed with the recess, and Dennis describes a cupholder that includes a moveable cylindrical component that extends telescopically away from a stationary cylindrical component that is coupled to a console of an automobile.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Mogil in view of Dennis.

Claims 7 and 8 depend from independent Claim 1. When the recitations of Claims 7 and 8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 7 and 8 likewise are patentable over Mogil in view of Dennis.

Claim 9 recites a container comprising “an insulated body comprising outer walls and a base, the insulated body defining a storage space; an insulated cover movably coupled with the insulated body; and an expandable beverage holder integrated with the insulated cover,

the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.”

Neither Mogil nor Dennis, considered alone or in combination, describes or suggests a container, as recited in Claim 9. More specifically, neither Mogil nor Dennis, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space, as required by Applicants’ claimed invention. Rather, in contrast to the present invention, Mogil describes a lid that includes circular recesses defined therein which are used to merely steady a beverage placed with the recess, and Dennis describes a cupholder that includes a moveable cylindrical component that extends telescopically away from a stationary cylindrical component that is coupled to a console of an automobile.

Accordingly, for at least the reasons set forth above, Claim 9 is submitted to be patentable over Mogil in view of Dennis.

Claims 11-13, 17, 18 and 20 depend from independent Claim 9. When the recitations of Claims 11-13, 17, 18 and 20 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 11-13, 17, 18 and 20 likewise are patentable over Mogil in view of Dennis.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1, 7-9, 11, 12, 17, 18 and 20 be withdrawn.

The rejection of Claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hodosh in view of U.S. Patent No. 2,880,902 to Owsen is respectfully traversed.

Hodosh is described above.

Owsen describes a collapsible drinking cup that has a generally truncated conical body (10) that is comprised of a plurality of annular stepped sections (12 and 14) which successively decrease in diameter. The plurality of sections (12 and 14) are integrally joined to one another and to a bottom (16) and extend telescopically to form a cup. Notably, Owsen does not describe or suggest an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Hodosh nor Owsen, considered alone or in combination, describes or suggests the claimed combination. Further, in contrast to the Examiner's assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Hodosh and Owsen, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory assertion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art suggests combining the disclosures.

As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant." In re Kotzab, 54 U.S.P.Q.2d 1308, 1316 (Fed. Cir. 2000); M.P.E.P. 2143.01.

Further, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). The Federal Circuit has determined that:

[i]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” In re Fritch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 U.S.P.Q. 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching or suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for at least this reason, Applicants submit that Claims 15 and 16 are patentable over Hodosh in view of Owsen.

Claims 15 and 16 depend from Claim 9 which recites a container comprising “an insulated body comprising outer walls and a base, the insulated body defining a storage space; an insulated cover movably coupled with the insulated body; and an expandable beverage holder integrated with the insulated cover, the expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space and configured to hold a beverage container.”

Neither Hodosh nor Owsen, considered alone or in combination, describes or suggests a container, as is recited in Claim 9. More specifically, neither Hodosh nor Owsen, considered alone or in combination, describes or suggests an expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space, as required by Applicants' claimed invention. Rather, in contrast to the present invention, Hodosh describes an insulated container that includes a pair of receptacles coupled within a top panel, wherein the receptacles include a waterproof skirt that only extends downwardly into a storage space and does not use telescoping construction, and Owsen describes a cup that includes a plurality of sections that only extends telescopically downward.

Accordingly, for at least the reasons set forth above, Claim 9 is submitted to be patentable over Hodosh in view of Owsen.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 15 and 16 be withdrawn.

In view of the foregoing amendment and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully submitted,



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